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IN THE

Supreme Court of the United States

OCTOBER TERM, 1959

No. 428

COLUMBIA BOILER CO., INC.,

Petitioner,

vs.

MANVILLE BOILER CO., INC.,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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Respondent respectfully prays that the issuance of a writ of certiorari to review the judgment in the above-entitled action of the United States Court of Appeals for the Fourth Circuit be denied.

Opinions Below

The opinion of the Court of Appeals for the Fourth Circuit is reported at 122 USPQ 545 and appears as Appendix A of Petitioner's brief. The District Court did not hand down an opinion, but made findings of fact and conclusions of law, which appear as Appendix B of Petitioner's brief.

Jurisdiction

The judgment of the Court of Appeals was entered on July 25, 1959. The jurisdiction of this Court is invoked under 28 U. S. C., Sec. 1254(1).

Statute Involved

Section 103 of the Patent Act of 1952, 66 Stat. 792-814, 35 U. S. C., Secs. 1-293, which is involved here, is printed in Appendix C to Petitioner's brief.

Question Presented

Respondent is dissatisfied with Petitioner's presentment of the "Questions Presented". The actual and only question that could be presented to this Court is the correctness of the decision of the Court of Appeals upon the facts of record in this patent infringement action. This is an ordinary patent case involving no conflict of decisions between different Courts of Appeals, no new or doubtful question of law, no conflict between the decision of the Court of Appeals and the applicable decisions of this Court or any other court, and no matter of public interest or importance.

Petitioner phrases the questions presented to encompass the broad question of what is the standard of invention under the Patent Act of 1952. Respondent will be the first to agree that this question has been raised by many Courts of Appeals in recent years, but wishes to point out that the Court of Appeals for Fourth Circuit was not required to face this issue in the present case. The Court of Appeals determined the issue of patentability based on the particular facts in the record before it. Since the Court of Appeals' opinion lacks any comment on the present standard of invention, logic and reason requires this Court to treat the decision as holding that all tests of invention were met.

Statement

The present case involves a routine patent infringement suit. Respondent brought suit against the Petitioner for infringement of United States Letters Patent No. 2,633,197

in the District Court for Eastern District of Virginia. The District Judge held the patent invalid and non-infringed. The Court of Appeals reversed this holding in a well-reasoned opinion reported at 122 USPQ 545. The Court of Appeals stated:

> "• • • The baffle was of such shape that the space above it, through which all flue gases had to be exhausted, and a vertical dimension less than that of the stack outlet, but Columbia, who manufactured the boiler and recognized the desirability of modifying its Stauffer design to permit a circular stack outlet, did not recognize the answer to its problem in its tubular boiler. What was not obvious to it during the many years during which the problem went unanswered, can hardly be said to have been obvious to Mandelburg so as to deprive him of reward for his contribution."

As Petitioner points out, the Court of Appeals did take a different view of Mandelburg's invention from that of the District Court, however, respondent submits that correction of erroneous conclusions of law and fact are not only within the province of the Courts of Appeals but indeed it was the primary purpose for their establishment. This proper exercise of their power is not a reason for review by this Court.

ARGUMENT

1. The Petition fails to state any reason for Supreme Court review of this case not equally applicable to every patent infringement action in which a Court of Appeals reverses a District Court to sustain the patent in suit. Respondent knows of no facet of fact or law involved that makes this other than an ordinary patent infringement case.

An analysis of progress of the present litigation reveals nothing more than a routine patent infringement action.

The case was presented to the trial court in a full and complete manner. District Court Judge Hatcheson found that Mandelburg's contribution to the domestic boiler art was not patentable and that Columbia did not infringe. The Court of Appeals with the benefit of a full and adequate record of the proceedings below and well aware of the provisions of Rule 52(a) of the Federal Rules of Civil Procedure reversed these findings.

The real issue in this case has been the application of 35 U. S. C., § 103 to the facts. Petitioner's *only* reasons for urging the granting of certiorari is that it wishes this Court to interpret this section of the Patent Act. Respondent is the first to agree that the question of patentability holds academic interest for all persons connected with our patent system. Since *Hotchkiss* v. *Greenwood*, 57 U. S. 248 (1851); *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84 (1941) and *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147 (1950) and now since the Patent Act of 1952, the question of changes in the standard of patentability have continued to stimulate much discussion among the patent bar. The issue of patentability in patent law like the issue of negligence in tort law is a concept incapable of clear delineation. As Judge Learned Hand's statement in *Lyon* v. *Bausch & Lomb Optical Co.*, 244 F. 2d 530 (2 Cir. 1955), the case Petitioner and others have cited so much in seeking the review of patent cases, perceptively and eloquently described this problem. He said at 537:

> "Such judicial attitudes are indeed the stuff of which much of the law is made;"

After each decision of this Court, the old question is always reposed. "Has the standard of invention been changed?" To answer this question every time it is asked would require this Court to review scores of patent infringement cases every Term.

2. The Court of Appeals' decision indicates that Mandelburg's invention meets *all* standards of invention and thus renders moot the determination of a proper standard for further application to the facts in this case.

Unlike many of other Courts of Appeals, the Fourth Circuit Court of Appeals in this case decided the question of patentability without reference to any possible change or present duality of patentable standards. *R. M. Palmer Co. v. Luden's Inc.*, 236 F. 2d 496 (3 Cir. 1956); *Fisch v. Gould*, 246 F. 2d 5 (3 Cir. 1957); *Steffan v. Weber Heating and Sheet Metal Company*, 237 F. 2d 601 (8 Cir. 1959).

The Court of Appeals stated, based on the record before it, that "What was not obvious to it [Columbia] during the many years during which the problem went unanswered, can hardly be said to have been obvious to Mandelburg." [Bracketed word added.] There is no factual basis for overturning the Court of Appeals' decision on the *basis of the application of an incorrect standard of invention.* The record before the Court of Appeals adequately supports its decision. Admittedly judges may differ in their opinion of the evidence but this Court should not review a case in order to substitute its opinion or "judicial attitude" for that of the lower court.

There is no special or important reason for granting an issuance of a writ of certiorari in this case.

CONCLUSION

The petition for writ of certiorari should be denied.

Respectfully submitted,

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